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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,360	03/29/2001	Suruliappa Gowper Jeganathan		1176

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CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
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TARRYTOWN, NY 10591-9005

EXAMINER

WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/806,360

Applicant(s)

JEGANATHAN ET AL.

Examiner

Amanda C Walke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10,12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10,12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

The papers filed on 6/11/2002 (certificate of mailing dated 6/5/2002) have not been made part of the permanent records of the United States Patent and Trademark Office (Office) for this application (37 CFR 1.52(a)) because of damage from the United States Postal Service irradiation process. The above-identified papers, however, were not so damaged as to preclude the USPTO from making a legible copy of such papers. Therefore, the Office has made a copy of these papers, substituted them for the originals in the file, and stamped that copy:

**COPY OF PAPERS  
ORIGINALLY FILED**

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If applicant wants to review the accuracy of the Office's copy of such papers, applicant may either inspect the application (37 CFR 1.14(d)) or may request a copy of the Office's records of such papers (*i.e.*, a copy of the copy made by the Office) from the Office of Public Records for the fee specified in 37 CFR 1.19(b)(4). Please do **not** call the Technology Center's Customer Service Center to inquiry about the completeness or accuracy of Office's copy of the above-identified papers, as the Technology Center's Customer Service Center will **not** be able to provide this service.

If applicant does not consider the Office's copy of such papers to be accurate, applicant must provide a copy of the above-identified papers (except for any U.S. or foreign patent documents submitted with the above-identified papers) with a statement that such copy is a complete and accurate copy of the originally submitted documents. If applicant provides such a copy of the above-identified papers and statement within **THREE MONTHS** of the mail date of this Office action, the Office will add the original mailroom date and use the copy provided by applicant as the permanent Office record of the above-identified papers in place of the copy made by the Office. Otherwise, the Office's copy will be used as the permanent Office record of the above-identified papers (*i.e.*, the Office will use the copy of the above-identified papers made by the Office for examination and all other purposes). This three-month period is not extendable.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Birbaum et al (5,597,854). Column and line citations are for the U.S. Patent.

Birbaum et al disclose a silver halide photographic material containing a stabilizer meeting the structural limitations of the present claims (column 29, lines 39-51, "14.", column 34, lines 31-65). The stabilizers are employed for stabilizing organic materials against the harmful effects of light, oxygen, and/or heat (see abstract). The compound may be added to a layer containing a UV absorber such as a protective layer or a layer between the red and green sensitive emulsion layers. The green sensitive emulsion layer contains a magenta coupler which is a pyrazolopyrazole, pyrazolotriazole, or pyrazolotetrazole (column 34, line 1 to column 35, line 57). From the weight of the polymer coating composition in column 59, and the teaching in column 29 that the stabilizer may be added in an amount of 0.1 to 5 % by wt of the polymer (s), the amount of stabilizer added to the layer (s) would fall within the scope of the present claim 8.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birbaum et al in view of Hinsken et al (4,325,863).

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Birbaum et al has been discussed above, but fails to specifically describe a compound meeting the limitations of the present formula VI. The reference cites Hinsken et al as describing suitable benzofuranone compounds. Those exemplified by Hinsken et al teach that the present R2 and R4 groups may contain pentyl groups (as in the present formula IV) and teach that they are equivalent to butyl groups (see compound 8).

Given the teaching of Hinsken et al that suitable substituents for positions R2 and R4 include pentyl groups, it would have been obvious to one of ordinary skill in the art to prepare the material of Birbaum et al using the benzofuranone compounds described in "14" of column 29 replacing the butyl group with a pentyl group given that they are taught to be equivalent by the reference, with reasonable expectation of forming a material having increased protection against light, oxygen, and/or heat.

#### ***Response to Arguments***

5. Applicant's arguments filed 6/11/2002 have been fully considered but they are not persuasive.

Applicant has argued that the benzofuranone compounds of Birbaum are listed as one possible UV absorbing and light stabilizing additives, and that there is no motivation to select these compounds from the list of possibilities. Applicant has argued that the preferred application of the reference are not a photography application. Although the reference lists 14 different types of stabilizers suitable for use in the present invention, and states that any may be used or multiple stabilizers may be added, each of the 14 types are specifically contemplated by the reference. One of ordinary skill in the art would have immediately envisaged employing any or all of the stabilizers taught in column 29.

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Additionally, in columns 34 to 42, the reference discusses the specifics of a silver halide photographic material, which is a preferred embodiment of the invention of the reference.

Applicant has also argued that the references fail to meet the present claims because the present claim 14 has been amended to limit the R<sub>4</sub> group to be bonded to the benzofuranone moiety via an oxygen molecule. While applicant has amended claim 14 in this manner, the claim still presents a choice of 2 compounds, V, and VI. In the position of VI where the "R<sub>4</sub>" substituent would be is a pentyl group. Also, in the previous office action the examiner stated that Birbaum in view of Hinsken met the limitations of VI, not V, and applicant has not amended this formula, so the examiner maintains her rejection. As stated above, Hinsken et al teaches that suitable substituents for positions "R<sub>2</sub>" and "R<sub>4</sub>" include pentyl groups, it would have been obvious to one of ordinary skill in the art to prepare the material of Birbaum et al using the benzofuranone compounds described in "14" of column 29 replacing the butyl group with a pentyl group given that they are taught to be equivalent by the reference, and the resultant compound would meet the present claim limitations.

In response to applicant's amendments and arguments, the 112 rejections and the rejections made over Odenwalder have been dropped.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
ACW  
September 3, 2002

Amanda C Walke  
Examiner  
Art Unit 1752

  
JANET BAXTER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700